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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,923	05/15/2001	Margaret P. Opolski	112280-121US CN	4361

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HALE AND DORR, LLP  
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BOSTON, MA 02109

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/855,923

Applicant(s)

OPOLSKI, MARGARET P.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14,16-19 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14,16-19 and 31-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

**Response to Amendment**

1. The amendment to the claims + newly added claims filed on 05/23/03 have been acknowledged and entered. However, applicant is herein apprised that claims 32-38 have been renumbered as 31-37 via Rule 1.126. The claims currently pending are 14, 16-19 and 31-37.

**Claim Rejections - 35 USC § 112**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

2. Claims 14, 16-19 and 31-37(renumbered) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no express support can be found for a) an acrylic polymer matrix, said acrylic polymer having an equivalent weight of functional moiety in the range of 200 to 1000 g/eq" per claim 14 and b) "weight average molecular weight" per claims 32 and 33(renumbered) and, as such and without any undisputable guidelines as to where support might be found, this engenders a New Matter situation.

3. Claims 14, 16 and 31-37(renumbered) are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for polymer matrixes which include poly(meth)acrylates and copolymers of ethylene and acrylic acid, does not reasonably provide enablement for the broadly recited "acrylic polymer matrix". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The claimed "acrylic polymer" matrix is broader than the enablement provided by the specification disclosure.

**Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

5. *Claims 14, 16 and 31-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

*The recited "the supporting acrylic polymer" per claim 14 @ lines 7-8 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis.*

#### **Double Patenting**

6. *The nonstatutory double patenting rejection made in the previous Office Action (paper no. 9, 12/20/02, paragraph no. 7) is herein withdrawn based on the amendments to the claims which include New Matter. However, applicant is further apprised that if the New Matter situation is obviated resulting in the cancellation of "acrylic polymer", the rejection of the claims under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 6,238,799 B1 may be reinstated.*

#### **Claim Rejections - 35 USC § 102**

6. *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

*A person shall be entitled to a patent unless –*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

7. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

8. *Claims 14, 16-19 and 31-37 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamasoe et al (U.S. 5,478,872).*

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*Yamasoe et al* disclose and exemplify hydrophilic surface treating aqueous solutions containing, as main components, a hydrophilic polymer having a specific molecular weight and containing a polyoxyalkylene chain of 10 wt % or more in terms of solid content, and a specific aqueous resin. More specifically, *Yamasoe et al* disclose, as one aspect of the present invention, a hydrophilic surface treating aqueous solution containing as its main components (I) an aqueous polymer including a polyoxyalkylene chain of 10 wt % or more in terms of solid content and having a weight-average molecular weight of 10,000 to 2,000,000; and (II) at least one aqueous resin selected from the group of an (a) unsaturated polymerizable monomer or unsaturated aqueous polymer including an amide group and/or hydroxyl group; (b) aqueous natural polymer or its derivatives; (c) aqueous alkyd resin; (d) aqueous maleic oil; (e) aqueous polyester resin; (f) aqueous polybutadiene resin; (g) aqueous polyamide resin; (h) aqueous epoxy resin; (i) aqueous polyurethane resin; (j) aqueous phenolic resin; (k) an aqueous amino resin; and (l) an aqueous inorganic crosslinking agent. In particular, *Yamasoe et al*, in another aspect of the invention, further provide for a hydrophilic surface treating aqueous solution containing in terms of solid content 5 to 50 parts by weight of polymer (I) having a weight-average molecular weight of 10,000 to 2,000,000 and including a polyoxyalkylene chain of 10 wt % or more and 5 to 50 parts by weight of polyacrylic acid in terms of solid content, with respect to a total of 100 parts by weight of components consisting of 5 to 25 parts by weight of the sodium salt and/or potassium salt of carboxymethyl cellulose; 25 to 50 parts by weight of the ammonium salt of carboxymethyl cellulose; and 25 to 70 parts by weight of N-methylol acrylamide. More specifically and in another aspect of the invention, *Yamasoe et al* further provide for a hydrophilic surface treating aqueous solution containing in terms of solid content 5 to 50 parts by weight of polymer (I) having a weight-average molecular weight of 10,000 to 2,000,000 and including a polyoxyalkylene chain of 10 wt % or more in terms of solid content, 5 to 50 parts by weight of polyacrylic acid, and 0.6 to 9 parts by weight of a zirconium compound (as Zr) (II), with respect to a total of 100 parts of components consisting of 5 to 25 parts by weight of the sodium salt and/or potassium salt of carboxymethyl cellulose; 25 to 50 parts by weight of ammonium salt of the carboxymethyl cellulose; and 25 to 70 parts by weight of N-methylol acrylamide. *Yamasoe et al* @ cols. 13-14 teach that additional adjuvants such as fungistats, antibiotics, surfactants, pigments, dyes, etc. can be included in the aqueous treating solutions. Most specifically, *Yamasoe et al* exemplify hydrophilic surface treating aqueous solutions, coated on metal surfaces such as aluminum, wherein said aqueous solutions are described as containing, inter alia, a polyethylene oxide, a polyvinyl pyrrolidone, an acrylic monomer and polyacrylic acid(Run 8) a polyethylene oxide, a

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*polyvinyl alcohol, a melamine resin and a polyacrylic acid(Run 31), a polyethylene oxide, carboxymethylcellulose, a zirconium compound, an acrylic monomer and polyacrylic acid(Runs 37-44) and a polyethylene oxide, a polyacrylic acid and a zirconium compound(Runs 77-102). Yamasoe et al therefore anticipate the instantly claimed invention with the understanding that the components of the hydrophilic coating of Yamasoe et al overlap in scope with the components of the hydrophilic coating per the claimed invention. It appears that the functional moiety of the acrylic polymer per Yamasoe et al has an equivalent weight falling within the scope of the claims. It would be expected that the crosslink density of the acrylic polymer system of Yamasoe et al is sufficient to engender a slip retention of the hydrophilic coating falling within the scope of the claims since the hydrophilic coating of Yamasoe et al is essentially the same as and made in essentially the same manner as applicant's claimed hydrophilic coating. The onus to show that this, in fact, is not the case is shifted to applicant under the guise of In re Best et al(195 USPQ 430). See the Abstract, cols. 1-15, the Runs and claims of Yamasoe. Yamasoe et al @ col. 37 further teach that the surface treating aqueous solution, useful for improving lubricity and processability, are applicable to anything which requires condensation-proof and antistatic properties such as glass or plastics for use in automobiles, electrical control equipment, watches, and the inner surfaces of other instrument panels, aiming at improving the visibility (anti-fogging treatment), etc. and sufficient to meet the article(s) per claim 19.*

*As to the other dependent claims, the limitations are either taught by Yamasoe et al, suggested by Yamasoe et al or would have been obvious to the skilled artisan and with a reasonable expectation of success.*

#### **Response to Arguments**

9. *Applicant's arguments, see paper no. 11, filed 05/23/03, with respect to the rejection(s) of claim(s) 14 and 16-19 under 35 USC 102/103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, based upon the amended claims and the newly added claims, a new ground(s) of rejection is made in view of Yamasoe et al.*

10. *Applicant's arguments with respect to the 112, 2<sup>nd</sup> paragraph issues have been considered and found persuasive. However, new 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph issues were created and rejection(s) based on such are as set forth supra.*

#### **Conclusion**

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11. The prior art cited on the attached PTOL FORM 892 and not relied upon is considered to be illustrative of the general state of the art.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.


Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *JMR*  
August 10, 2003